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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,306	04/25/2001	Kurt E. Spears	10011001-1	7110

7590

04/01/2003

HEWLETT-PACKARD COMPANY
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EXAMINER

ROBINSON, MARK A

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 04/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/842,306

Applicant(s)

SPEARS, KURT E.

Examiner

Mark A. Robinson

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe made of record.

Watanabe shows the limitations of these claims as discussed previously, but does not show a video display. However, video displays are very common and an example of such is shown by the newly cited reference to Lemelson (note the paragraph bridging columns 10-11 and the first three paragraphs of col. 11 for a teaching of a video display used in conjunction with an image scanner). Use of light emitted from a known video display would have been obvious to the ordinarily skilled artisan at the time of invention in concert with Watanabe's scanner in order to enable the capture of images from such a source.

3. Claims 1 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2001-24847 made of record.

JP '847 shows the limitations of these claims as discussed previously, but does not show a video display. However, video displays are very common and an example of such is shown by the

newly cited reference to Lemelson (note the paragraph bridging columns 10-11 and the first three paragraphs of col. 11 for a teaching of a video display used in conjunction with an image scanner). Use of light emitted from a known video display would have been obvious to the ordinarily skilled artisan at the time of invention in concert with the scanner of JP '847 in order to enable the capture of images from such a source.

Response to Arguments

Applicant's arguments submitted with the response are not persuasive.

Applicant has argued that no reference has been cited as showing a video display as a light source, and that a prima facie case of obviousness has not been made.

In response, patents to Lemelson, Withgott et al, and Lichtfuss have been cited as showing examples of well known video displays. For example, Lemelson (as noted above) teaches in column 10 line 57 through column 11 line 60 the use of a video display as a light or image source in a scanning device. Further, the examiner has provided a motivation for the use of a video display with the scanner, namely that such an arrangement would enable the capture of images or other information from video sources. This would provide the obvious advantage of

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increased versatility for the image scanner since different types of input sources could be captured for storage and retrieval, etc. Applicant has not addressed this motivation set forth by the examiner, and thus the rejection is still deemed to be valid.

Applicant has further argued that the limitations of claim 8 are not met by the references and so the rejection of claim 8 is not proper.

However, claim 8 states that "the reflecting surface can be reoriented..." but does not set forth particular structure to accomplish this function or intended use. This limitation merely requires the ability to reorient the mirror. Clearly, the mirrors shown by both Watanable and JP '847 can be reoriented, since it is possible for these mirrors to be displaced, removed, etc. Accordingly, the limitation of claim 8, as presently set forth, is met by the references.

Conclusion

4. The prior art (Lemelson, Withgott et al, and Lichtfuss) made of record and not relied upon is considered pertinent to applicant's disclosure. Note that these references were only cited by the examiner in response to applicant's remarks on page 4 of the amendment as evidence of a feature asserted to be well

known in the art. Thus, their citation does not raise new issues. See MPEP 2144.03.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Robinson whose telephone number is (703) 305-3506.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached at (703) 308-1687. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

MR

3/26/03


MARK A. ROBINSON
PRIMARY EXAMINER